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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/008,874	11/08/2001	Toshiya Nakamura	Hohjoh Case 46A	6044

7590 03/17/2004

Flynn, Thiel, Boutell & Tanis, P.C.
2026 Rambling Road
Kalamazoo, MI 49008-1699

EXAMINER

TRINH, MINH N

ART UNIT	PAPER NUMBER
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3729

DATE MAILED: 03/17/2004

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/008,874

Applicant(s)

NAKAMURA, TOSHITKA

Examiner

Minh Trinh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2003.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-22 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☒ Claim(s) 12, 13, 15, 16, 18 and 19 is/are allowed.
6) ☒ Claim(s) 11, 14, 17 and 20 is/are rejected.
7) ☒ Claim(s) 21 and 22 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/536547.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. The amendment filed in paper No. 6 (dated 12/29/2003) has been fully considered and made of record.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 11, 14, 17 and 20-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
 - a) The term: "them" (see claim 11, line 13) which is not clear as to what being referring as "them" in the claims. Please clarify.
 - b) The phrase: " forming the conductive film " (claim 14, line 2) lacks proper antecedent basis.
 - c) The phrase: "from 3-40 wt.%" should be changed to: -- from 3 % to 40% by weigh--.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 11, 14, and 17 as best understood are rejected under 35 U.S.C. 102(b) as being anticipated by Sano et al (US 5,822,176).

Sano et al disclose a method for making ceramic body of the present application comprising steps of: preparing an unbaked laminated body 3 comprising a ceramic layer 2a-b (see Fig. 1) and internal electrodes 4's being laminated on one another; forming external electrodes 5's (col. 2, lines 59-60) in contact with the internal electrodes 4's at end surfaces of the laminated body (see col. 1, lines 30-36); applying and drying a conductor paste, into which is added a material common with a ceramic forming the ceramic layer of the laminated body, on edge portions of the unbaked laminated body (see col. 6, lines 34-38), baking the laminated body (see col. 6, lines 19-22, see also table 4, at cols. 9-10).

As applied to claim 14, Sano et al disclose the conductive film materials similar to that as recited in claim 14 (see col. 5, lines 26-35).

As applied to claim 17, Sano et al disclose the limitation of claim 17 (see col. 6, line 54).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 20 as best understood is rejected under 35 U.S.C. 103(a) as being unpatentable over Sano et al. Sano et al as applied and relied upon above do not teach the configurations as described in claim 20. It would have been an obvious matter of design choice to choose any desired conductive paste configurations since applicant has not disclosed that the conductive paste from 3-40wt.% as recited in claim 20, lines 1-2 is critical, patentably distinguishing feature and it appears that the invention would perform equally well with the configuration as described by the prior art reference (see Sano et al, col. 3, lines 54-55).

Response to Arguments

8. Applicant's arguments with respect to claims 11-22 have been considered but are moot in view of the new ground(s) of rejection.

Allowable Subject Matter

9. Claims 12, 13, 15-16, 18-19 are allowed as reasons set forth in prior Office Action. Further, regarding claims 21-22, these claims would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action (see above) and to include all of the limitations of the base claim and any intervening claims.

Interviews After Final

10. Applicant notes that an interview after a final rejection will not be granted unless the intended purpose and content of the interview is presented briefly, in writing (the agenda of the interview must be in writing). Such an interview may be granted if the examiner is convinced that disposal or clarification for appeal may be accomplished with only nominal further consideration. Interviews merely to restate arguments of record or to discuss new limitations which would require more than nominal reconsideration or new search will be denied. See MPEP 714.13 and 713.09.

Prior Art References

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Prior art references are cited for their teaching of method of manufacturing laminated capacitor, or the like.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not


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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh Trinh whose telephone number is (703) 305-2887. The examiner can normally be reached on Monday -Thursday 8:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (703) 308-1789. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

A handwritten signature in black ink, appearing to be 'M. Trinh', with a long horizontal line extending to the right.

M. Trinh
Examiner Group 3729

Mt
3/02/04